

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Todd M. Lynton**

Confirmation No.: **7358**

Serial No.: **10/067,442**

Group Art Unit: 3689

Filing Date: **February 4, 2002**

Examiner: **Michael J. Fisher**

For: **Product Registration System**

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellant submits this Reply in response to the Examiner's Answer dated October 28, 2008 in connection with the above-identified application. This reply is being filed within two months of said answer.

Howard does not teach or suggest registering a device with a manufacturer wherein the registration request message does not include information identifying the user

The Examiner continues to rely upon Figure 3 and column 4, lines 15-23 of Howard as allegedly teaching "the device is registered without requiring ownership information, merely information on the device." Examiner's Answer, page 5. The Examiner has misread Howard and thus has factually erred.

Figure 3 of Howard is stated to be a "schematic diagram illustrating an example of a device identification string including an optional feature component." *Id.*, column 3, lines 57-59. The cited portion of Howard reads:

By receiving a device identification string or “device idstring,” the host system 20 recognizes that the external device 30 is integrated with the host system 20 so that the external device 30 may properly receive instructions and applications from the host system 20. An example of a device idstring having data fields for a Hewlett-Packard LASERJET2200 laser printer is illustrated in FIG. 3. Accordingly, as discussed in detail below, the external device 30 provides a device idstring.

Neither Figure 3 nor the cited passage from column 4 support the Examiner’s assertion as neither portion of Howard is concerned with registering a product with a manufacturer as featured in the claims. Rather the idstring is used in installing the device in a host system.

The sole mention of product registration in Howard is found at column 7, lines 36 to 40 that states:

As the system 10 is initially connecting with the host system 20 and the external device 30, the host system 20 runs the installer 22. The installer 22 is an executable installation program that is associated with the external device 30. The installer 22 installs software components in the operating system 29 of the host system 20. In general, the installer 22 installs software components for enabling the host system 20 to operate the external device 30. The installer 22 installs at least one device driver 26 as well as other device utilities, such as for example a font management utility or a status monitor. ***The installer 22 may also interactively provide the user with merchandising information associated with the external device 30, such as verification of warranty registration and software license agreements.***

The Examiner builds upon the highlighted sentence, stating “[a]s its status is checked, it would have been obvious ...to provide a mechanism for registering the warranty in case it has not been registered yet.” Examiner’s Answer, page 3.

Appellant argued that the Examiner failed to explain how any of the cited portions of Howard suggest that any registration of the product with the manufacturer that may occur be done in a manner where information identifying the user is not included. Appeal Brief, pages 8-11. Rather than answer the argument, the Examiner shifts positions, arguing “the technical ability to improve the base device in the same way and the result of the improvement is predictable as the prior art teaches checking to see if the device has been registered (using the

input from the device which is the device identifier and not the owner identifier)...” Examiner’s Answer, page 5. The Examiner’s new position is legally and factually in error.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Here, there is no “rational underpinning” to the Examiner’s assertion of obviousness. Appellant argued that, at the time of this development in the art, warranty registration typically included the submission of information to the manufacturer identifying the user, citing, *e.g.*, specification, paragraph [0011]. Appeal Brief, pages 9-10. Howard, which is the only evidence relied upon by the Examiner, does not teach registering the product with the manufacturer, only at best checking to see if it was registered, and in no way teaches or suggests that any registration with the manufacturer that may occur takes place without any information identifying the user be contained in the registration message sent to the manufacturer.

The Examiner asserts that “registering devices is old and well known ...and applying the known technique to yield a known improvement was predictable.” Examiner’s Answer, pages 5-6. While registering a product with the manufacturer may have been known, the Examiner does not point to any evidence in Howard that registering a device with the manufacturer *without identifying the user* was known. There is no suggestion in Howard to do so. Obviousness must be based upon the subject matter of a claim as a whole. 35 U.S.C. § 103(a). Thus, the Examiner’s rejection is legally and factually in error.

Nor does the Examiner’s reliance upon Plug-n-Play help his case. Examiner’s Answer, page 6. As explained in the Appeal Brief at page 16, the input featured in the claims must be capable of registering a device with the manufacturer without including information identifying the user. Again, the Examiner has failed to explain how pushing a button on a Plug-n-Play device results in the subject matter of any of the claims on appeal.

Conclusion

Appellant respectfully request reversal of the Final Rejection of claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 under 35 U.S.C. § 103(a).

Date: December 10, 2008

/Wendy A. Choi/

Wendy A. Choi

Registration No. 36,697

WOODCOCK WASHBURN LLP
Cira Centre
2929 Arch St., 12th Floor
Philadelphia PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439